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In the Supreme Court of the United States

OCTOBER TERM, 1952

No. 130

JAMES V. MARTIN, PETITIONER

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion and dissenting opinion in the Court of Customs and Patent Appeals (R. 67-81) are reported at 195 F. 2d 303.

JURISDICTION

The decision of the Court of Customs and Patent Appeals (R. 82) was entered on March 18, 1952.

The petition for a writ of certiorari was filed on June 16, 1952. Petitioner invokes the jurisdiction of this Court under 28 U.S.C. 1256.

QUESTION PRESENTED

Whether this Court has jurisdiction to issue a writ of certiorari to review a decision of the Court of Customs and Patent Appeals affirming the respondent's denial of an application for extension of the term of a patent.

STATUTES INVOLVED

The pertinent parts of the statutes involved are set forth in the Appendix, *infra*, pp. 9-10. See also footnote 1, *infra*.

STATEMENT

Petitioner applied to the Commissioner of Patents for an extension of the term of Patent No. 2068300, pursuant to the provisions of the Act of June 30, 1950, Public Law 598, 81st Congress, 2d Session (35 U.S.C. (Supp. IV) 115 *et seq.*), which permits patentees who were deprived of the opportunity to exploit their patents by reason of service in "the military or naval forces" during the war to obtain extensions of the life of their patents.[1] Peti-

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[1] Section 1 of the Act of June 30, 1950, Public Law 598 provides as follows:

> Any person who served honorably in the military or naval forces of the United States at any time between December 7, 1941, and September 2, 1945—
>
> (a) who is the inventor or discoverer of an invention or discovery for which a patent was granted to him prior to September 2, 1945, the original term of which had not expired prior to said date and which is still owned by

tioner had served in the Maritime Service of the United States, as first mate, first officer, and master of merchant vessels owned by the War Shipping Administration and allocated to the Navy for the purpose of transporting cargo and personnel in the Pacific. The Commissioner rejected the application on the ground that petitioner's service in the merchant marine was not to be regarded as service in "the military or naval forces." Pursuant to the statute, petitioner appealed to the Court of Customs and Patent Appeals, under R.S. 4914, *infra*, p. 10); and that court, one judge dissenting, affirmed.

ARGUMENT

We think that the judgment of the court below is correct and would not in any event warrant review by this Court.[2] At the threshold, however, we think

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him, or who was prior to said date and continuously thereafter the sole owner of a patent for an invention or discovery which had not expired prior to said date; and

(b) who, between December 7, 1941, and the date of the termination of his service but not later than the date of enactment of this Act, was not receiving income from said patent or patented invention or discovery; or whose income therefrom was substantially reduced as a result of his said service or because of the war, may obtain an extension of his patent for the term specified herein, upon application to the Commissioner of Patents within one year after the enactment of this Act and upon complying with the provisions of this Act. The period of extension of such patent shall be a further term from the expiration of the original term thereof equaling twice the length of the portion of his said service between the dates of December 7, 1941, and September 2, 1945, during which his patent was in force.

[2] The Court below relied, correctly we think, on definitions of the term "military and naval forces" contained in related statutes. These include statutes in which Congress has provided for the preservation in the civilian *status quo* of various

that this Court is without jurisdiction to review decisions of the Court of Customs and Patent Appeals in patent or trademark cases. The reasons for our view have been set forth in detail in the respondents' Briefs in Opposition in *Dalton & Cooley* v. *Marzall,* No. 87, October Term 1951, certiorari denied, 342 U. S. 818, and *Thompson* v. *Learned,* No. 496, October Term 1951, certiorari denied, 342 U. S. 942, and in the respondent's Memorandum in *Shackell* v. *Marzall,* No. 763, October Term 1951, certiorari denied June 9, 1952, to all of which the Court is respectfully referred. In outline, the argument is as follows:—

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other rights of persons serving in the armed forces, such as the Soldiers and Sailors Relief Act of 1940, 54 Stat. 1179, 50 U.S.C. App. 511, in which the term "military and naval forces" is defined to exclude persons in the merchant marine, and also various statutes in which Congress conferred veterans' benefits on officers and members of crews employed by the War Shipping Administration, but made no reference to their rights as patentees. Act of March 24, 1943, c. 26, 57 Stat. 45. Cf. *Osbourne* v. *United States,* 164 F. 2d 767 (C.A. 2). It is also significant that the House subcommittee holding hearings on the bill that became P.L. 598, the Act here in question, considered and rejected a proposal to extend the law's benefits to all patentees whose exploitation of their patents suffered because of wartime shortages of materials or for other reasons. The bill was purposely limited to veterans, whose military service removed them "from the scenes of their livelihoods and occupations." S. Rept. No. 1190, 81st Cong., 1st Sess., p. 2. Any extension of the Act to merchant seamen, whose war service was in pursuit of their occupation, would be contrary to this legislative purpose.

Also, we think that the present case is of minor importance. The period for applying under the present law for extensions of the life of patents has expired. Petitioner is the only member of the merchant marine who has attempted to avail himself of the law. Only 160 applications from veterans of all branches of the armed services were received by the Commissioner under this law.

It was settled by *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U. S. 693, that decisions of the Court of Appeals of the District of Columbia on appeals from decisions of the Patent Office in patent and trademark applications were not reviewable by this Court. Such a decision was held to be not a judicial judgment but "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U. S. at 698-699. Hence such a decision was not a justiciable case or controversy and was beyond the constitutional power of this Court to review.

After the *Postum Cereal* case, jurisdiction of appeals from the Patent Office in patent and trademark matters under R. S. 4911-4914 was transferred from the Court of Appeals for the District of Columbia to the Court of Customs and Patent Appeals, until then named the Court of Customs Appeals.[3] Act of March 2, 1929, c. 488, 45 Stat. 1475, *infra*, p. 9. After the transfer of this jurisdiction to the Court of Customs and Patent Appeals, this Court, in denying certiorari for want of jurisdiction in *Pacific Northwest Canning Co.* v. *Skookum Packers' Ass'n*, 283 U. S. 858 (trademark

[3] Appeals from rejections of applications for extensions under the law here in question are governed by the same provisions that apply to appeals from denials of applications for patents in the ordinary case. Section 3 of P.L. 598 provides in part: "Where an extension is refused the applicant therefor shall have the same remedy by appeal from the decision of the Commissioner to the United States Court of Customs and Patent Appeals as is now provided by law where an applicant for patent is dissatisfied with the decision of the Patent Office Board of Appeals." 35 U.S.C. (Supp. IV) 117.

case), and *McBride* v. *Teeple*, 311 U. S. 649 (patent case), cited the *Postum Cereal* case as authority for its denial of the writs, thus affirming its prior holding that it has no jurisdiction to review decisions on appeals from Patent Office determinations in patent and trademark matters.

Petitioner invokes 28 U.S.C. 1256, *infra*, p. 9, but that section does not confer jurisdiction on this Court, although its language is broad enough to do so. The *Postum Cereal* decision was based on constitutional grounds, and no statute could confer a jurisdiction withheld by the Constitution. But we think also that 28 U.S.C. 1256 was not intended to confer jurisdiction on this Court in cases like the present.

That section is part of the Act of June 25, 1948, 62 Stat. 869, codifying into law Title 28 of the United States Code. Before that Act, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating to customs cases.[4] This was Section 195 of the old Judicial Code as amended.[5] Sec-

[4] Summary appeals (such as that in the present case) in patent and trademark matters are to be distinguished from appeals from judgments of the United States Customs Court in customs cases. The latter are judicial in character and are reviewable by this Court. *E.g.*, *Barr* v. *United States*, 324 U.S. 83; *Board of Trustees of University of Illinois* v. *United States*, 289 U.S. 48. The Court of Customs and Patent Appeals may properly be given jurisdiction over both justiciable and non-justiciable matters. *Ex parte Bakelite Corp.*, 279 U.S. 438.

[5] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

tion 195 combined two provisions: one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court—in customs cases—and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256. Nothing in the codifying act of 1948 or in its history suggests that Congress had any intention of giving this Court power to review a class of cases over which jurisdiction had previously been withheld or to diminish the ambit of the *Postum Cereal* case.[6]

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[6] Applicants for patents have available to them at their own option an alternative path of review of adverse decisions of the Patent Office. They may proceed by suit in equity under R.S. 4915 (35 U.S.C. 63) in the district courts. In such cases the courts of appeals have jurisdiction on appeal and this Court has jurisdiction to review by writ of certiorari. Cf. *Hoover Co.* v. *Coe*, 325 U.S. 79. It is not clear that this alternative remedy is available in cases like the present, but this does not affect the question of this Court's jurisdiction. See *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, 701.

CONCLUSION

For the foregoing reasons and for the reasons stated in the respondents' Briefs in Opposition in *Dalton & Cooley* v. *Marzall, supra,* and in *Thompson* v. *Learned, supra,* the petition for a writ of certiorari should be denied.

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JULY, 1952.

APPENDIX

Act of March 2, 1929, c. 488, 45 Stat. 1475-1476:

That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.

Sec. 2(a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

28 U.S.C. 1256:

Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

R.S. 4911, as amended, 44 Stat. 1336, 45 Stat. 1476, 53 Stat. 1212, 35 U.S.C. 59a:

Sec. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal ac-

cording to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

R.S. 4914, 35 U.S.C. 62:

The court [Court of Customs and Patent Appeals], on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

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